



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2015-0034]

July 2015 Update on Subject Matter Eligibility

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Update; Request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) prepared interim guidance (2014 Interim Patent Eligibility Guidance) for use by USPTO personnel in determining subject matter eligibility in view of then-recent decisions by the U.S. Supreme Court (Supreme Court). The USPTO published the 2014 Interim Patent Eligibility Guidance in the Federal Register, and sought public comment on the 2014 Interim Patent Eligibility Guidance. The USPTO has since produced an update pertaining to patent subject matter eligibility titled July 2015 Update: Subject Matter Eligibility, which is available to the public on the USPTO's Internet Web site, in

response to the public comment on the 2014 Interim Patent Eligibility Guidance. The July 2015 Update: Subject Matter Eligibility includes a new set of examples and discussion of various issues raised by the public comments, and is intended to assist examiners in applying the 2014 Interim Patent Eligibility Guidance during the patent examination process. The USPTO is now seeking public comment on the July 2015 Update: Subject Matter Eligibility.

COMMENT DEADLINE DATE: To be ensured of consideration, written comments on July 2015 Update: Subject Matter Eligibility must be received on or before [Insert date 90 days after the date of publication in the FEDERAL REGISTER].

ADDRESSES: Comments on the July 2015 Update: Subject Matter Eligibility must be sent by electronic mail message over the Internet addressed to:

2014_interim_guidance@uspto.gov. Electronic comments submitted in plain text are preferred, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. The comments will be available for viewing via the Office's Internet Web site (<http://www.uspto.gov>). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Raul Tamayo, Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7728, or Michael Cygan,

Senior Legal Advisor, Office of Patent Legal Administration, by telephone at 571-272-7700.

SUPPLEMENTARY INFORMATION: The 2014 Interim Patent Eligibility Guidance, prepared for use by USPTO personnel in determining subject matter eligibility under 35 U.S.C. 101, was published in the Federal Register on December 16, 2014. See 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 FR 74618 (Dec. 16, 2014).

The USPTO also sought public comment on the 2014 Interim Patent Eligibility Guidance, along with additional suggestions on claim examples for explanatory example sets.

The USPTO received over sixty comments from the public. The public comments include the following six major themes: (1) requests for additional examples, particularly for claims directed to abstract ideas and laws of nature; (2) further explanation of the markedly different characteristics analysis; (3) further information regarding how examiners identify abstract ideas; (4) discussion of the prima facie case and the role of evidence with respect to eligibility rejections; (5) information regarding application of the 2014 Interim Patent Eligibility Guidance in the Patent Examining Corps; and (6) explanation of the role of preemption in the eligibility analysis, including a discussion of the streamlined analysis.

The USPTO has produced a July 2015 Update: Subject Matter Eligibility responding to each of the six major themes from the public comments. The July 2015 Update: Subject

Matter Eligibility includes three appendices. The first appendix (Appendix 1) provides new examples that are illustrative of major themes from the comments. The second appendix (Appendix 2) is a comprehensive index of examples for use with the 2014 Interim Patent Eligibility Guidance, including new and previously issued examples. The third appendix (Appendix 3) lists and discusses selected eligibility cases from the Supreme Court and the U.S. Court of Appeals for the Federal Circuit. The July 2015 Update: Subject Matter Eligibility is intended to assist examiners in applying the 2014 Interim Patent Eligibility Guidance during the patent examination process.

The July 2015 Update: Subject Matter Eligibility, including the appendices, are available to the public on the USPTO's Internet Web site. The USPTO is now seeking public comment on the July 2015 Update: Subject Matter Eligibility.

Dated: July 15, 2015.

Michelle K. Lee
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
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